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| APPLICATION NO.                                                            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/504,875                                                                 | 02/16/2000  | Toshikazu Nakajima   | 99USFP421-M.K.      | 5579             |
| 466                                                                        | 7590        | 03/10/2004           | EXAMINER            |                  |
| YOUNG & THOMPSON<br>745 SOUTH 23RD STREET 2ND FLOOR<br>ARLINGTON, VA 22202 |             |                      | LY, NGH I H         |                  |
|                                                                            |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                            |             |                      | 2686                |                  |
| DATE MAILED: 03/10/2004                                                    |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/504,875

Applicant(s)

NAKAJIMA, TOSHIKAZU

Examiner

Nghi H. Ly

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2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa et al (US 5,926,769) in view of Inoue et al (US 6,332,024).

Regarding Claims 20, 23, 25 and 28, Valimaa teaches a method of operating a portable telephone having plural numbered dialing keys that each have a unique identity for dialing a telephone number (Fig. 2, keypad 22, It is Inherent that each key on the keypad represents a number, which has a unique identity, for dialing a telephone number), the method comprising the steps of establishing the telephone in a call origination mode, operating one of the plural numbered dialing keys and determining the unique identity of the operated one of the plural numbered dialing keys (Col.4, Lines 31-41, wherein a long depression of key number 5 recalls the telephone number stored at memory location 5), changing from the call origination mode to an operating mode in which a call cannot be originated based solely on the determined unique identity of the operated one of the plural numbered dialing keys (Fig.3, Step B, wherein long key depression changes from dialing mode to read/write mode).

Valimaa does not specifically disclose *as soon as the unique identity of the operated one of the plural keys is determined* and changing from the call origination

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mode to an operating mode in which a call cannot be originated based solely on the determined unique identity of the operated one of the plural numbered dialing keys.

Inoue teaches *as soon as the unique identity of the operated one of the plural keys is determined* (column 8, lines 6-10, see *"Further, when the user presses the second auxiliary soft key 4B corresponding to "Call release" in the calling mode A2, the call is released, and the mode is shifted back to the above mentioned initial mode A0"*, and see column 7, lines 25-32, for the *"mode A0"*, also see Fig.4A, for more details of *"mode A0"*) and changing from the call origination mode to an operating mode in which a call cannot be originated based solely on the determined unique identity of the operated one of the plural numbered dialing keys (also see column 8, lines 6-10, and see column 7, lines 25-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Inoue into the system of Valimaa so an operation can be performed while looking at the instructions on the display screen without taking help of manual (see Inoue, column 2, lines 7-13).

Regarding Claims 21, 24, 26 and 29, the combination of Valimaa and Inoue further teaches the operating mode in which a call cannot be originated is a stored telephone number search mode (see Valimaa, Fig.3, Col.4, Lines 31-41, wherein the Read Mode is to recall a stored telephone number).

Regarding Claim 22, see Claim 23 for the teaching of Valimaa and Inoue.

Regarding Claim 27, see Claim 23 for the teaching of Valimaa and Inoue.

3. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa et al (US 5,926,769) in view of Inoue et al (US 6,332,024) and further in view of Giel et al (US 5,881,377).

Regarding claims 30-33, the combination of Valimaa and Inoue teaches claims 22, 23, 25 and 28. The teaching of Valimaa and Inoue does not specifically disclose the second set includes keys for "0" and "1" and the first set includes two of the plural numbered dialing keys that are next to each other.

Giel teaches the second set includes keys for "0" and "1" and the first set includes two of the one numbered dialing keys that are next to the other key (see column 3, lines 43-48 and see fig.3, *the second set includes keys for "0" and "1" and the first set includes one of the plural numbered dialing keys that are next to the, see numbered dialing key "0" is next to the keys "\*" and "#"*).

The combination of Valimaa, Inoue and Giel does not specifically disclose the first set includes two of the plural numbered dialing keys that are next to each other. However, those skilled in the art thus would appreciated that the teaching of Giel could be modified such that the first set includes two of the plural numbered dialing keys that are next to each other without changing the scope and spirit of Giel's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Valimaa, Inoue and Giel in order to provide the first set includes two of the plural numbered dialing keys that are next to each other.

***Response to Arguments***

4. Applicant's arguments with respect to claims 20-33 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

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03/04/04

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